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Paper No. 37

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MAIL

JAN 14 2004

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

In re Application of:

Dovek et al.

Application Serial No.: 09/067,795

Filed: April 28, 1998

For: FLUX-GUIDED MAGNETORESISTIVE HEAD
USING A PERPENDICULAR RECORDING MEDIA

DECISION
ON PETITION

This is a decision on the petition, filed on January 2, 2003 under 37 C.F.R. §1.181 to request that the Response filed on April 1, 2003 be entered and considered by the examiner.

As stated by Petitioner, the Board of Patent Appeals and Interferences rendered a decision in the instant application, March 26, 2003 (paper No. 33). Said decision affirmed the rejection of claims 1-4, 6, 7, 11, 13-15, 17-19, 21, 24-27, 29-34, 37, 42-48, 50, 53, 57, 58, and 60 based upon the Tanaka et al. reference (U.S. Patent 5,486,967). Claims 10, 49 and 55 were reversed in said decision, based upon the Tanaka et al. reference. The decision reversed the examiner's rejection of claims 1-60 based upon the Hesterman et al. reference (U.S. Patent No. 5,434,733). Finally, the decision also reversed the examiner's rejection of claim 55 based upon the Somers reference (U.S. Patent No. 5,097,371).

In response to the Board of Patent Appeals and Interferences rendered decision, Applicants filed a response on April 1, 2003 (paper No. 34), requesting amendment of claims 1, 17 and 30 by incorporating the limitations of claims 5, 20 and 36 respectively; claims 5, 20 and 36 were then requested to be cancelled; and claims 61-66, 71-83 were presented for the first time in applicant's response, placing into independent form claims 8, 12, 16, 22, 28, 35, 38-41, 49, 51, 52, 54-56 and 59 respectively. New claims 67 through 70 were presented to depend from claim 66 which corresponded to claims 23 through 26 respectively.

On August 14, 2003 the Office mailed an Advisory Action indicating that Applicant's response (paper No. 34) would not be entered "...because prosecution is closed and Applicant's proposed new claim(s) present additional claims without canceling a corresponding number of finally rejected claims...".

MPEP section 1214.06 provides guidelines on the processing of an application after the Board of Patent Appeals and Interferences renders a decision, affirming the examiner in part.

MPEP §1214.06 Examiner Sustained in Whole or in Part

III. CLAIMS REQUIRE ACTION

If the decision of the Board is an affirmance in part and includes a reversal of a rejection that brings certain claims up for action on the merits, such as a decision reversing the rejection of generic claims in an application or ex parte reexamination proceeding containing claims to nonelected species not previously acted upon, the examiner will take up the application or reexamination proceeding for appropriate action on the matters thus brought up. However, the application or reexamination proceeding is not considered open to further prosecution except as to such matters. [emphasis added]

After the Board of Patent Appeals and Interferences rendered its decision (paper No. 33) March 26, 2003, the application was not considered open to further prosecution except to matters reversed in said decision. Had Applicant's response merely added claims 61 through 83 as indicated above, then entry of the response would have been acceptable. However, Applicant's attempt to incorporate claims 5, 20 and 36 into claims 1, 17 and 30 respectively, altered the scope of the remaining dependent claims. For example, prior to the Board of Patent Appeals and Interferences decision, claim 2 would have only required the particulars of claim 1 and the limitations set forth in claim 2 itself. With Applicant's proposed response, claim 2 would now require the particulars of claim 1, claim 5 as well as the limitations set forth in claim 2. Therefore, Applicant has attempted to amend the claims which would require further prosecution.

Accordingly, the petition under 37 C.F.R. §1.181, to request invoking the supervisory authority of the Commissioner, such that the Response filed on April 1, 2003 would be entered and considered by the examiner is DENIED.

The application will be forwarded to the examiner for appropriate action.



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